

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 22-34 were cancelled previously. Claims 18-21, 39-45, and 48-57 were requested to be cancelled in response to a restriction requirement. Claims 1, 13, 16, 17, 58, 61, and 64 are amended. The amendments are supported at least by Figures 7 and 8 and the corresponding text in the present application.

Claims 1-17, 35-38, 46, 47, and 58-66 are pending in this application.

I. Rejection of Claims 1-17, 36-38, 46, 58, 61, and 64 Under 35 U.S.C. § 103(a)

In section 4 of the Office Action, Claims 1-17, 36-38, 46, 58, 61, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,597,679 to Willars (*Willars*) in view of US Patent No. 7,181,218 to Ovesjo *et al.* (*Ovesjo*) and further in view of US Patent No. 5,428,816 to Barnett *et al.* (*Barnett*). Independent Claims 1, 58, 61, and 64 have been amended, rendering the rejection moot.

1. Willars does not show “providing a list of a plurality of radio access means in a communications system to a network element of the communications system”

Willars describes a system in which a mobile station can roam from one cellular service area into a new cellular service area where the new cellular service area uses a “wholly different cellular communications scheme.” (*Willars*, col. 6, lines 4-7.) The mobile station in *Willars* can accommodate such changes because it has a “dual receiver mode” that enables the mobile station to operate in both the previous communication scheme (e.g., GSM) and a new, different communication scheme (e.g., WCDMA). (*Willars*, col. 6, lines 10-17.)

Willars, however, does not teach or suggest “providing a list of a plurality of radio access means in a communications system to a network element of the communications system” as recited in Claim 1. Although different in scope, Independent Claims 58, 61, and 64 include a similar claim element.

The mobile station with a dual receiver described in *Willars* receives communications from a first service area and then, when the mobile station is in a second service area, from the second service area. Nevertheless, these communications from different service areas are not “a list of a plurality of radio access means” as claimed. *Willars* simply receives communications in a particular service area in communication with the mobile station. *Willars* does not teach or suggest that a network element of the communication system is given a list of a plurality of radio access means in a communications system where the plurality of radio access means use different communication systems. *Ovesjo* and *Barnett* do not provide this missing teaching either.

For at least this reason alone, the rejection of Claim 1 based on the combination of *Willars*, *Ovesjo* and *Barnett* cannot be properly maintained. Claims 2-17, 36-38, and 46 depend from Claim 1 and are allowable for at least the same reasons.

2. *Barnett* does not show “creating a prioritized ordering of the radio access means” which the Examiner acknowledges is missing from *Willars* and *Ovesjo*

On page 4 of the Office Action, the Examiner comments:

The combination of *Willars* and *Ovesjo* does not explicitly teach that that the ordering of the radio access means are created with a prioritized ordering and selected based on the created prioritized ordering.

(emphasis added.) To provide the teaching, the Examiner points to *Barnett*. The Examiner claims that “*Barnett* teaches that cells of a candidate handoff list are assigned a handoff measurement priority (abstract; column 5, lines 34-62).” (Office Action, page 4, emphasis added.) The Examiner is correct that *Barnett* teaches “handoff measurement priority” involving cells. However, the teaching that the Examiner acknowledges is missing from *Willars* and *Ovesjo* is creating a prioritized ordering of the radio access means not cells.

Therefore, the combination of *Willars*, *Ovesjo* and *Barnett* fails to teach “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the

mobile station based on the selected target radio access means" (underlining added) as recited in Claim 1. For this reason alone, the rejection of Claim 1 based on the combination of *Willars*, *Ovesjo* and *Barnett* cannot be properly maintained. Claims 2-17, 36-38, and 46 depend from Claim 1 and are allowable for at least the same reasons.

3. **Willars, Ovesjo and Barnett fail to teach all of the claim elements of Claim 1**

As detailed above, the combination of *Willars*, *Ovesjo* and *Barnett* does not teach at least "providing a list of a plurality of radio access means in a communications system to a network element of the communications system," (underlining added) as recited in Claim 1, and "creating a prioritized ordering of the radio access means," "selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering," and "sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means" (underlining added) as recited in Claim 1. Claims 2-17, 36-38, and 46 depend from Claim 1 and include these elements.

An obviousness rejection cannot be properly maintained where the references do not disclose all of the recited claim elements. For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of Claims 1-17, 36-38, and 46.

II. **Rejection of Claims 35, 47, 59, 60, 62, 63, 65, and 66 Under 35 U.S.C. § 103(a)**

In section 5 of the Office Action, Claims 35, 47, 59, 60, 62, 63, 65, and 66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Willars*, *Ovesjo*, and *Barnett* and further in view of US Patent No. 5,655,217 to Lemson (*Lemson*). Applicant respectfully traverses the rejection.

On page 8 of the Office Action, the Examiner indicates that the combination of *Willars*, *Ovesjo* and *Barnett* does not teach or suggest:

determining if performing the compressed mode measurements
at the mobile station is successful;

if performing the compressed mode measurements is unsuccessful, selecting a second target radio access means of the plurality of radio access means based on the ordering; and

performing second compressed mode measurements at the mobile station based on the second selected target radio access means, said second measurements for selecting a second cell associated with the selected second target radio access means.

The Examiner points to *Lemson* as providing these teachings. *Lemson* describes “a system for allocating one or more ranges of transmission frequency to the communications network, in order to prevent the network from interfering with received signals of an incumbent radio system.” (Abstract). *Lemson* describes re-measuring a portion of the spectrum if a “noise burst exists.” (*Lemson*, fig. 5 and col. 17, lines 29-59.) However, *Lemson* does not select a second target radio access means of the plurality of radio access means based on the ordering or perform second compressed mode measurements at the mobile station based on the second selected target radio access means. *Lemson* simply re-measures a portion of the spectrum.

For this reason alone, the rejection of Claims 35, 47, 59, 60, 62, 63, 65, and 66 based on the combination of *Willars*, *Ovesjo*, *Barnett* and *Lemson* cannot be properly maintained.

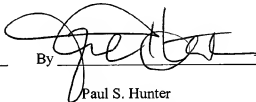
Lemson also does not teach or suggest the claim elements from Claim 1 missing from the combination of *Willars*, *Ovesjo*, and *Barnett*, namely “providing a list of a plurality of radio access means in a communications system to a network element of the communications system,” (underlining added), and “creating a prioritized ordering of the radio access means,” “selecting a target radio access means of the plurality of radio access means based on the created prioritized ordering,” and “sending a request to the mobile station to perform compressed mode measurements at the mobile station based on the selected target radio access means” (underlining added). The Examiner does not suggest that *Lemson* teaches these claim elements and in fact *Lemson* does not. Claims 35, 47, 59, 60, 62, 63, 65, and 66 depend from Claim 1. An obviousness rejection cannot be properly maintained where the references do not disclose all of the recited claim elements. For at least the foregoing reasons, Applicants respectfully request withdrawal of the rejection of Claims 35, 47, 59, 60, 62, 63, 65, and 66.

Applicants believe that the present application is in condition for allowance.
Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,



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